

### **Remarks**

Reconsideration of the subject application in view of the present amendment is respectfully requested.

By the present amendment, Claim 1 has been amended. Claim 7 has been added.

Based on the foregoing amendments and the following remarks, the application is deemed to be in condition for allowance, and action to that end is respectfully requested.

The Examiner rejected Claims 1-6 under 35 U.S.C. §103(a) as being unpatentable over Gantner, U.S. Patent No. 5,025,870 (Gantner) in view of Minamidata, U.S. Patent No. 4,282,938 (Minamidata). It is respectfully submitted that claims 1-7 are patentable over the combination of Gantner and Minamidata. Gantner represents a prior art of which the present invention is an improvement. The drawbacks of Gantner are discussed in the preamble of the specification.

Minamidata relates to a different type of a vibrating machine and disclose neither a percussion unit nor axial guide means for supporting the percussion unit in a tool housing for a limited axial displacement in the housing and including two axially spaced, flexurally deformable, articulated arms secured

in the housing with a possibility of a limited axial displacement and without any slip motion relative to the housing.

In Minamitate, the springs 18,18a are radially spaced from each other. Further, in Minamitate, the springs 18,18a are secured to the housing (fore handle 16) with a possibility of a slip motion relative thereto, being pivotable about the thrust shafts 19,19a. If Gantner and Minamitate were combined it would result in a portable tool with a dynamic vibration absorber with absorbing springs arranged radially relative to the percussion unit and in series with each other, as shown in Fig. 6. There is not suggestion whatsoever in Minamitate to arrange flexurally deformable, articulated arms on opposite axial sides of the percussion unit for supporting the percussion unit in the housing for a limited axial displacement.

It is respectfully submitted that the present invention, as defined in Claim 1, would not be obvious over the combination of Gantner and Minamitate.

Under MPEP § 2143 *prima facie* case of obviousness requires that three basic criteria be met.

First, there must be some suggestion or motivation, either in the references or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be

a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitation.

It is respectfully submitted that the first and third elements of *prima facie* obviousness has not been established.

“obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggesting supporting the combination. Under section 103, teachings of references can be combined only if there is some suggesting or incentive to do so.”

In re Fritch, 23 U.S.P.Q. 2d 1780, 1783 (Fed. Cir 1992) (footnote omitted) (emphasis in original). See also In re Sernaker, 217 U.S.P.Q. 1, 6 (Fed. Cir. 1983); SmithKline Diagnostics, Inc. v. Helena Laboratories Corp., 8 U.S.P.Q. 2d 1397, 1399 (Fed. Cir. 1989); In re Fine, 5 U.S.P.Q. 2d 1596, 1598 (Fed. Cir. 1988).

There is no suggestion, incentive or motivation in the cited references for the combination on which the Office Action relies. A statement that it would have been obvious to one skilled in the art to make modifications to the references is not sufficient to establish a *prima facie* case of obviousness. MPEP §2143.01 relying on Ex Parte Levengood, 28 U.S.P.Q. 2d 1300 (Bd. Pat. App. & Inter.

1993). In order to establish a *prima facie* case of obviousness, “it is necessary for the Examiner to present evidence, preferably in the form of some teaching, suggesting incentive or influence in the prior art, or in the form of generally available knowledge, that one having ordinary skill in the art would have been led to combine the relevant teachings.” *Id.* At 1301 (emphasis in original).

The Federal Circuit has held that a claimed invention was not obvious, where “[c]onspicuously missing from [the] record as any *evidence*, other than the PTO’s speculation (if it be called evidence) that one skilled in the art would have been motivated to make the modification of the prior art “necessary to arrived at the claimed invention. *In re Jones* 21 U.S.P.Q. 2d 1941 (Fed. Cir. 1992).

*Ex Parte Clapp*, 227 U.S.P.Q. 972, 973 (Bd. Pat. App & Inter. 1985) requires that when the references do not suggest the invention “. . . the Examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teaching of the references.” No such line of reasoning is seen in the Office Action.

The Office Action asserts that it would have been obvious to provide the power tool of Gantner with flexural deformable arms [of Minamidate] . . .since the vibration-decoupling arrangement will perform the same task (?) as the present invention (page 2, sixth paragraph). Applicants respectfully disagree with this assertion. As discussed above, the flexural arms of Minamidate are not designed

for nor would be capable of supporting the percussion unit for a limited axial displacement.

In view of the above, it is respectfully submitted that the combination of Gantner and Minamidate does not make obvious the present invention, as defined in Claim 1, and the present invention is patentable over said combination.

Claims 2-7 depend on Claim 1 and are allowable for the same reasons Claim 1 is allowable and further because of specific features recited therein which, when taken alone and/or in combination with features recited in Claim 1, are not disclosed or suggested in the prior art. Thus, Claim 7 recites that the articulated arms are directly secured to the percussion mechanism without any slip motion relative thereto. This is not disclosed in Minamidate..

### **CONCLUSION**

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance, and allowance of the application is respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawing be further amended or corrected in formal respects, in order to place in case in condition for final allowance, then it is respectfully requested that such amendment or correction be carried out by

Examiner's amendment and the case passed issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, the Examiner is invited to telephone the undersigned.

Respectfully submitted



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